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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,874	07/24/2003	John L. Baugh	D5407-213	3032

25397 7590 08/26/2004

DUANE, MORRIS, LLP  
SUITE 3150  
3200 SOUTHWEST FREEWAY  
HOUSTON, TX 77046

EXAMINER
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DANG, HOANG C

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/626,874

Applicant(s)

BAUGH ET AL.

Examiner

Hoang Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/04 & 7/24/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of the species of Figures 5-11 in the reply filed on May 3, 2004 is acknowledged. The traversal is on the ground(s) that the species of Figures 5-11, 20-26 and 27-30 all have in common gaps left after initial expansion for cement to pass. This is found persuasive and the restriction requirement between the species of Figures 5-11, 20-26 and 27-30 is therefore withdrawn.
2. Claims 55 (the species of Figures 1-4 or 12-15) and 56 (the species of Figures 16-19) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse (regarding the species of claims 55 and 56) in the reply filed on May 3, 2004.

### ***Claim Objections***

3. Claims 37-47 are objected to because of the following informalities: The recitation of "defining said gap as at least one passage between said longitudinal contact between said tubular string and said cased wellbore" is complete. A passage cannot be defined between one longitudinal contact. It appears that the phrase "between said longitudinal contact" should be --between two of said longitudinal contacts--..  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 48-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation of "running a tubular string having a reduced diameter, to an outer dimension small enough to fit into said cased borehole, onto a cased borehole where such tubular string's original dimension, on at least a part thereof, was at least as large as the inside diameter of a cased wellbore" in claim 48, lines 2-5 has no support in the original specification and is considered as "new matter".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 29, 30, 31, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindsey, Jr. (US 4,926,938) or Garcia (US 4,033,640).

The claimed method steps read exactly on the Lindsey, Jr. reference when slips 30 or/and 56 are considered as a "portion" of the tubular string 12. This "portion" of the tubular string 12 is expanded into contact with the cased borehole for support thereof (see figure 2 and column 3, lines 21-42). Lindsey, Jr. also discloses that "gaps" are left

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between the tubular string 12 and the cased borehole that are used for passage of cement (see figures 2-3 and column 3, lines 42-54 and column 5, lines 51-62). These gaps latter are closed when the cement is hardened (see column 5, lines 56-58).

As for claims 31 and 34, the "swage" does not distinguish from conical member 40 or 54.

As for claim 34, the lower end of the conical member 54 is inside slips 56 which is considered as a portion of the tubular string.

Similarly, the claimed method steps read exactly on the Garcia reference when slips 24c are considered as a "portion" of the tubular string 12. This "portion" of the tubular string (30,17,18) is expanded into contact with the cased borehole for support thereof. Garcia also shows "gaps" are left between the tubular string (30,17,18) and the cased borehole that are used for passage of cement (see Figure 1). These gaps latter are closed when the cement is hardened.

As for claims 31 and 34, the "swage" does not distinguish from conical member 23c.

As for claim 33, the conical member 23c moves downwardly to expand slips 24c.

As for claim 34, the lower end of the conical member 23c is inside slips 24c which is considered as a portion of the tubular string.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 29-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,446,724 or claims 1-8 of U.S. Patent No. 6,631,765. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are broader and therefore read on the invention as defined by the claims of the U.S. Patent No. 6,446,724 and 6,631,765, respectively.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

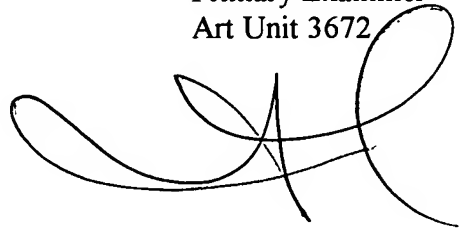
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 703-308-2149. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang  
Primary Examiner  
Art Unit 3672

A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke, positioned below the printed name and title.